

**REMARKS**

Claims 1, 3-4, 6-32, 34-40, and 42 are pending in this application. By this Amendment, claims 1, 34, 37 and 42 are amended and claims 2, 5 and 41 are canceled without prejudice to or disclaimer of the subject matter recited therein. No new matter is added.

**I. Pending Claims 1, 3-4, 6-32, 34-40 and 42 Define Patentable Subject Matter**

The Office Action rejects claims 1-6, 10-18, 20, 23, 25-27, 30, 34 and 37-42 under 35 U.S.C. §102(b) over German Patent No. DE 296 14 364 to Stange. This rejection is respectfully traversed.

With respect to independent claims 1, 34 and 42, the Patent Office continues to improperly ignore the recited "configured for fixing onto a receptacle" language, which as repeatedly argued is a positive recitation of structure that must be given patentable weight. When evaluating claims for obviousness (as well as anticipation), all of the limitations of the claims must be considered and given weight. MPEP §2143.03. *Ex parte* Grasselli, 23 USPQ 393 (Bd. App. 1983) *aff'd* mem. 738 F.2d 453 (Fed. Cir. 1984).

The recited "configured for" differs from intended use in that it is a positive recitation of structure that achieves the resultant fixing. For example, when read in light of Applicants' specification, Fig. 4 and paragraph [0012] show a screw thread as a suitable corresponding structure that configures the base portion for fixing onto the receptacle. Dependent claim 9 defines more specific structure, as well as dependent claim 35, which adds the receptacle removably mountable to the base. Thus, claims 1, 34 and 42 positively recite a structure that achieves such fixing.

Despite this recited structure, the Office Action and Advisory Action continue to allege that this is merely "intended use" and that Stange "could" be fixed to a receptacle. First, as mentioned above, this is positive structure that must be given patentable weight.

Second, the allegation that Stange "could" be fixed to a receptacle is factually flawed because Stange is directed to a standalone brush with a base that is not intended to be fixed and cannot be fixed to a receptacle without some additional, undisclosed structure. Because a reference must teach each and every feature in order to be anticipatory and Stange fails to do so, a *prima facie* case of anticipation has not been met.

Moreover, independent claims 1, 34 and 42 recite, *inter alia*, that "the base portion and the handle portion cooperate in such a manner as to enable a user to secure the handle portion in at least two predefined application positions relative to the base portion." For example, Applicants' specification teaches that the applicator can apply substance (such as make-up or mascara) to a user's eyelashes, eyebrows, etc. at two different inclinations (paragraph [0041]) allowing, for example, applying of make-up or mascara to the left eye or right eye using the same hand movements (paragraph [0010]).

Stange, however, provides a brush that is used to apply product such as shaving cream in a single disclosed vertical position. Because of the nature of the vertical position and water being on the brush, Stange provides a different angled position for the sole disclosed purpose of drying the brush after use. Thus, this latter position is not taught to be useful for applying shaving cream by the user and is thus not a second application position for applying a product.

Because a reference must teach each and every feature in order to be anticipatory and Stange fails to do so, a *prima facie* case of anticipation has not been met with respect to independent claims 1, 34, and 42.

Moreover, in making the rejection, the Office Action alleges that Stange provides multiple positions and that "one would be able to put it in any mode that would be comfortable to the user." However, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests

the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). No such desirability is found in Stange as the sole purpose of the extra position is to allow for drying. Thus, the Examiner's position may only be gleaned from impermissible hindsight consideration of Applicants' specification.

With respect to method claim 37, the Office Action fails to make a prima facie case of anticipation because it fails to identify a teaching of the method step of modifying a direction of the base between two different application modes. Instead, as discussed above, Stange provides a brush that is mobile relative to the handle so as to enable drying of the brush (without soap or water remaining trapped within the bristles). Thus, Stange suggests only a single application mode (i.e., conventional use in the vertical position for application of shaving cream), and a different angled position for the sole purpose of drying (which does not apply product to the user). This latter position is necessitated by the vertical positioning of the brush above the handle to achieve drying. This latter position is not taught to be useful for applying shaving cream and thus cannot be considered an application mode.

Because a reference must teach each and every feature in order to be anticipatory and Stange fails to do so, a *prima facie* case of anticipation has not been met with respect to independent claim 37 as the specific method step of use is not disclosed.

Therefore, because each and every feature of the independent claims are not found in Stange, Applicant respectfully submits that independent claims 1, 34, 37 and 42 and claims dependent therefrom are patentable over Stange. Accordingly, withdrawal of the rejection over Stange is respectfully requested.

The Office Action also rejects claims 1-5, 7-18, 20, 23, 25-27, 30-32, and 34-42 under 35 U.S.C. §103(a) over U.S. Patent No. 6,237,609 to Vasas in view of Stange. This rejection is respectfully traversed.

Vasas discloses a mascara brush and has no teaching or motivation to configure the stem or cap to render the stem or cap mobile in relation to the remainder of the device.

Vasas also has no appreciation of advantages achieved from use of two different application modes for the brush.

As discussed above, Stange is not "configured for" fixing onto a receptacle and is instead a stand alone brush designed to merely be placed on a flat surface with the brush exposed for drying. Stange also is not concerned with advantages achieved by having two application modes which allow, for example, the brush to apply mascara to the left or right eye with the same hand movement (Applicant's paragraph [0010]) or to change the angle of attack for a different application effect (Applicant's paragraph [0009]). Instead, a shaving brush as in Stange just needs to generally apply shaving cream over a face in a non-exact manner. Thus, with respect to independent method claim 37, Stange like Vasas fails to teach two application modes.

One of ordinary skill in the art also would not have been motivated to combine Stange and Vasas. The Office Action alleges that motivation to combine comes from the "teaching of Stange to make a more ergonomical handle." However, there is no such teaching in Stange. The purpose of Stange is not an ergonomical handle, but a problem with drying after use. That is, Stange discloses a brush having a tuft of bristles that is mobile relative to the handle so as to enable drying of the device without water or soap remaining trapped within the bristles. Such a problem is not faced by Vasas as its brush extends downward into a receptacle. Moreover, like Vasas, only a single application mode is disclosed in Stange. Neither appreciates advantages of two different application modes to achieve different styling effects or to apply mascara to the left or right eye with the same hand movement. Thus, the rotatable base of Stange would have no utility in Vasas.

Accordingly, independent claims 1, 34, 37 and 42 and claims dependent therefrom patentably distinguish over Vasas and Stange. Withdrawal of the rejection is respectfully requested.

The Office Action also rejects claims 7-9, 31, 32, and 35 under 35 U.S.C. §103(a) over Stange in view of U.S. Patent No. 3,97028 to Shay. This rejection is respectfully traversed.

Shay fails to overcome the deficiencies of Stange with respect to independent claim 1. Accordingly, claims 7-9, 31, 32, and 35 are allowable for their dependence on allowable base claim 1 and for the additional features recited therein. Withdrawal of the rejection is respectfully requested.

The Office Action also rejects claim 19 under 35 U.S.C. §103(a) over Stange in view of U.S. Patent No. 5,815,875 to Yamada. This rejection is respectfully traversed.

Yamada fails to overcome the deficiencies of Stange with respect to independent claim 1. Accordingly, claim 19 is allowable for its dependence on allowable base claim 1 and for the additional features recited therein. Withdrawal of the rejection is respectfully requested.

The Office Action also rejects claim 21 under 35 U.S.C. §103(a) over Stange. This rejection is respectfully traversed.

Stange is discussed above and fails to teach each and every feature of independent claim 1. Accordingly, claim 21 is allowable for its dependence on allowable base claim 1 and for the additional features recited therein. Withdrawal of the rejection is respectfully requested.

The Office Action also rejects claim 22 under 35 U.S.C. §103(a) over Stange in view of U.S. Patent No. 4,922,575 to Riemann. This rejection is respectfully traversed.

Riemann fails to overcome the deficiencies of Stange with respect to independent claim 1. Accordingly, claim 22 is allowable for its dependence on allowable base claim 1 and for the additional features recited therein. Withdrawal of the rejection is respectfully requested.

The Office Action also rejects claim 24 under 35 U.S.C. §103(a) over Stange in view of U.S. Patent No. 5,137,038 to Kingsford. This rejection is respectfully traversed.

Kingsford fails to overcome the deficiencies of Stange with respect to independent claim 1. Accordingly, claim 24 is allowable for its dependence on allowable base claim 1 and for the additional features recited therein. Withdrawal of the rejection is respectfully requested.

The Office Action also rejects claim 29 under 35 U.S.C. §103(a) over Stange in view of U.S. Patent No. 3,164,856 to Samaras et al. (Samaras). This rejection is respectfully traversed.

Samaras fails to overcome the deficiencies of Stange with respect to independent claim 1. Accordingly, claim 29 is allowable for its dependence on allowable base claim 1 and for the additional features recited therein. Withdrawal of the rejection is respectfully requested.

**II. Rejoinder of Withdrawn Claim 28 is Requested**

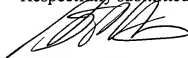
Claim 28 remains withdrawn from representation. However, rejoinder of claim 28 is respectfully requested in view of the allowability of claim 1 from which it depends.

**III. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 3-4, 6-32, 34-40 and 42 are thus earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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WPB:SPC/jnm

Attachment:

Request for Continued Examination  
Petition for Extension of Time

Date: October 29, 2007

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